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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/826,930 | 04/19/2004 | Daniel Joseph Qualiano | | 1608 |

7590 10/26/2004

DANIEL JOSEPH QUALIANO
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EXAMINER

STERLING, AMY JO

ART UNIT PAPER NUMBER

3632

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/826,930 | QUALIANO, DANIEL JOSEPH | |
| | Examiner | Art Unit | |
| | Amy J. Sterling | 3632 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Information to Pro Se Inventors
Regarding responses to Office Actions

INTRODUCTION

An examination of this application reveals that applicant may be unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application. The value of a patent is largely dependent upon skillful preparation and prosecution. Although the services of a registered patent attorney or agent is advised, the Office cannot aid in selecting an attorney or agent. 37 C.F.R. 1.31; M.P.E.P. 401. However, Applicant is encouraged to peruse the publication entitled "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

DISCUSSION

The following discussion provides general information for Applicant's benefit regarding an applicant's response, new matter, the period for response, and the certificate of mailing.

I. Response by Applicant

The applicant **MUST** respond to every ground of rejection and objection made in an Office action. 37 C.F.R. 1.111. The applicant will generally present arguments that the examiner's rejections or objections were made in error; or amend the specification, drawings, and/or claims to overcome the rejection or objection. Amendments to the application may not introduce new matter. 37 C.F.R. 1.118.

Unless the Office explicitly requests the return of a paper, all papers mailed to the applicant are intended to be kept by the applicant for his own records. **The response must be signed by ALL applicants.** 37 C.F.R. 1.33.

A. Arguments

Should the applicant disagree with the examiner's position, the applicant should distinctly and specifically point out the supposed errors in the examiner's action with arguments under the heading "Remarks" in the response. 37 C.F.R. 1.111. In addition, the applicant must discuss the references cited by the examiner that explain how the claims avoid the references or patentably distinguish from them. *Id.*

B. Revised Amendment Practice

The United States Patent and Trademark Office (USPTO or Office) as of July 30, 2003 is requiring applicants to submit amendments in a revised format as set forth

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herein as the revised 37 CFR 1.121. This can be found at

<http://www.uspto.gov/web/patents/ifw/>

Strict Compliance with the revised format is required. The Office will notify applicants of amendments that are not accepted because they do not comply via a Notice of Non-Compliant Amendment which can then be corrected and resubmitted within a set period.

I. Begin Sections on Separate Sheets:

Each section of an amendment paper (e.g., Amendments to the Specification, Amendments to the Claims, Remarks) shall begin on a separate sheet to facilitate separate indexing and electronic scanning of the document. For example, each of the following four sections of an amendment paper must start on a separate sheet:

- a.) Introductory Comments
- b.) Amendments to the Specification
- c.) Amendments to the Claims
- d.) Remarks

II. Submit Only One Version (with markings) of an Amended

Part: The requirement to provide two versions of a replacement paragraph, section, or claim (a clean version and a marked up version), as set forth in current 37 CFR 1.121, is waived where the format set forth

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below is followed.

III. Amendments to the Claims

A. A Complete Listing of Claims is Always Required:

If an amendment adds, changes or deletes any claim, a detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remains under examination in the application, must be presented, and the amendment to the claims is expressed in the listing. The listing shall be presented as follows:

1. Ascending Order and Status Identifier Required

The listing shall be provided in sequential ascending numerical order (beginning with claim 1). A status identifier shall be provided for every claim in a parenthetical expression following the claim number (e.g., "Claim 1. (original)"). A list of acceptable status identifiers is set forth in part B, below. The text of all claims under examination shall be submitted each time any claim is amended. Cancelled and withdrawn claims should be indicated by only the claim number and status. The text of cancelled or withdrawn claims should not be presented.

2. Markings in Currently Amended Claims Required

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All claims being currently amended shall be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). No separate "clean" version should be submitted for currently amended claims, as this requirement has been eliminated.

Markings should only be made in claims being currently amended in an amendment paper. Double brackets may be used for the deletion of five or fewer characters or difficult to perceive text.

3. Only Clean Text Required for Other Claims Under Examination.

The text of pending claims not being currently amended that are under examination shall be presented in a clean version in the listing. Any claim presented in clean version constitutes an assertion that it has not been changed relative to the immediate prior version.

4. Status to Effect Claim Cancellation or Addition.

A claim may be cancelled by merely indicating the status of the claim as cancelled. Any new claim added by amendment must be indicated by the appropriate status identifier and shall not be underlined. Thus, added new claims of status (new), (reinstated - formerly claim #_) and (re-presented - formerly dependently claim #_) must be presented in clean version. Additional claims may be subject to additional fees, as

appropriate.

5. When Grouping of Claims is Permitted. Consecutive cancelled or withdrawn claims may be aggregated into one line of the listing (e.g. Claims 1 - 5 (cancelled)).

B. Status Identifiers that May be Used:

In order to promote uniformity and consistency, only the following seven (7) defined status identifiers should be used to indicate the status of the claims (in parentheses after the claim number):

1. (Original): Claim filed with the application following the specification (i.e., not added by preliminary amendment).
2. (Currently amended): Claim being amended in the current amendment paper.
3. (Cancelled): Claim cancelled or deleted from the application.
4. (Withdrawn): Claim still in the application, but in a non-elected status. Must include the text of the claim.
5. (Not entered), Claim was presented, but not entered. Text is excluded.
6. (Previously presented): Claim presented in an earlier amendment paper.
7. (New): Claim being added in the current amendment paper.

IV. Amendments to the Specification

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Amendments to the specification are to be made by presenting replacement paragraphs, sections or a substitute specification marked up to show changes made relative to the immediate prior version, as set out in 37 CFR 1.121(b). The changes should be shown by strikethrough (for deleted matter) or underlining (for added matter). No accompanying "clean" version shall be supplied. The amendments to the specification shall be presented only one time, and will not appear in successive amendment documents.

V. Amendments to the Drawings

Amendments to the drawing figures shall be made by presenting replacement figures which include the desired changes, without markings, and which comply with 1.84. The changes shall be explained in the accompanying remarks section of the amendment paper. If the amended drawings are not approved, the applicant will be notified in the next Office action. Any amended drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure number in the amended drawing should not be labeled as "amended." The applicant may also submit annotated drawing sheets in addition to the required replacement drawing sheets. For further information on the prototype image electronic processing of patent applications, please contact the Search and Information Resources Administration at: image.processing@uspto.gov. Any questions regarding the submission of amendments pursuant to the revised practice set forth in this notice should be directed to Elizabeth Dougherty

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(Elizabeth.Dougherty@uspto.gov), Gena Jones Eugenia.Jones@uspto.gov) or Joe Narcavage (mailto:Joseph.Narcavage@uspto.gov). For information on the waiver or legal aspects of the program, please contact Jay Lucas (Jay.Lucas@uspto.gov) or Rob Clarke (Robert.Clarke@uspto.gov).

II. New Matter

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. 37 C.F.R. 1.118. "New matter" constitutes any material which meets the following criteria:

- (1) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- (2) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

See M.P.E.P. 706.03(o). For example, in the amendment to the claim discussed above, the new limitation of "four legs" would not constitute new matter if the specification or drawings originally described the inclusion of four legs on the chair.

III. Period For Response

An Office action generally sets a time period in which the applicant has to respond to every rejection and objection (called a shortened statutory period). 37 C.F.R. 1.134. This time period for response appears on the cover letter (form PTO-

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326) of the Office action. Usually, a 3 month shortened statutory period is set.

M.P.E.P. 710.02(b). The applicant's response must be received within the time period listed on the cover letter, or the application will be held abandoned. 37 C.F.R. 1.135.

Currently, the Office allows the time period for response to be extended past the shortened statutory period up to a maximum of 6 months (called the maximum 6 month statutory period). In order to extend the period of response past the shortened statutory period, a request for an extension of time and payment of the appropriate fee is required. 37 C.F.R. 1.136. The request must state that it is for "an extension of the period for response under 37 C.F.R. 1.136(a)." The following table lists the required fees for extensions of the shortened statutory period:

| Months Past Response Date | Fee Due (Small / Large Entity) |
|----------------------------------|---------------------------------------|
| Response within Time Allowed | None / None |
| 1 | \$ 55 / \$ 110 |
| 2 | \$ 205 / \$ 410 |
| 3 | \$ 465 / \$ 930 |
| 4 | \$ 725 / \$ 1,450 |

| | |
|---|-------------------|
| 5 | \$ 985 / \$ 1,970 |
|---|-------------------|

It is important to note that no extension of time is permitted that extends the period for response past the maximum 6 month statutory period. Responses received after the maximum 6 month statutory period will be held abandoned. 37 C.F.R. 1.135.

Three examples are provided:

Example 1:

A complete response is filed four months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$195 (for a small entity; \$390 for a large entity) for a 2 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. 1.136(a)."

Example 2:

A complete response is filed five months and one day after the mailing date of an Office action. The Office action sets a **2 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$695 (for a small entity; \$1,390 for a large entity) for a 4 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. 1.136(a)."

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Example 3:

A complete response is filed six months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response is held abandoned even if accompanied by a fee and a request for an extension of time. Remember, extensions of time may not be used to extend the period for response past the maximum 6 month statutory period. 37 C.F.R. 1.135.

IV. Certificate of Mailing

To ensure that the Applicant's mailed response is considered timely filed, it is advisable to include a "certificate of mailing" on at least one page (preferably on the first page) of the response. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on (date).

(Typed or printed name of the person signing this certificate)

(signature)

CERTIFICATE OF TRANSMISSION

Alternatively, if applicant wishes to respond by facsimile rather than by mail, another method to ensure that the Applicant's response is considered timely filed, is to include a "certificate of transmission" on at least one page (preferably on the first page) of the response. This

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method should be used by foreign applicants without access to the U.S. Postal Service. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)____-____ on (date).

(Typed or printed name of the person signing this certificate)

(signature)

These "Certificates" may appear anywhere on the page, and may be handwritten or typed.

They must be signed, and the date must be the actual date on which it is mailed or transmitted.

For the purpose of calculating extensions of time, the date shown on the certificate will be construed as the date on which the paper was received by the Office, regardless of the date the U.S. Postal Service actually delivers the response, or the fax is "date-stamped" in. In this way, postal or transmission delays do not affect the extension-of-time fee.

In the event that a communication is not received by the Office, applicant's submission of a copy of the previously mailed or transmitted correspondence showing the **originally** signed Certificate of Mailing or Transmission statement thereon, along with a statement from the person signing the statement which attests to the timely mailing or transmitting of the correspondence, would be sufficient evidence to entitle the applicant to the mailing or transmission date of the correspondence as listed on the Certificate of Mailing or Transmission, respectively.

NOTICE TO APPLICANT: In the case of lost or late responses the use of other "receipt producing" forms of mailing a correspondence to the Patent Office, such as Certified Mail, or a private shipper such as FedEx, **WILL NOT** result in the applicant getting the benefit of the mailing date on such receipts. These receipts are not considered to be acceptable evidence since there is nothing to "tie-in" the receipt with the particular document allegedly submitted.

CONCLUSION AND CAVEAT

The above discussion is not intended to be an exhaustive list of all the topics that may be relevant to this particular Application. The information was provided to familiarize Applicant with the portions of a response that have historically caused problems for *pro se* inventors.

Furthermore, even if Applicant's response is in accordance with the information provided above, there is no guarantee that every requirement of the patent laws (35 U.S.C. 1-376), patent rules (37 C.F.R. 1.1-150.6), and Patent Office policy (M.P.E.P. 101-2591) has been met. The adequacy of a response is determined on a case-by-case basis. See 37 C.F.R. 1.111; M.P.E.P. 714.02.

DETAILED ACTION

This is the first Office Action for application number 10/826,930 Cooking Lid and Utensil Holder, filed on 4/19/04. Claims 1-6 are pending.

Claim Objections

Claim 1 is objected to because of the following informalities: Claim 1, line 1 contains a period. The claim should be all one sentence with a period appearing at the end of the claim only. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

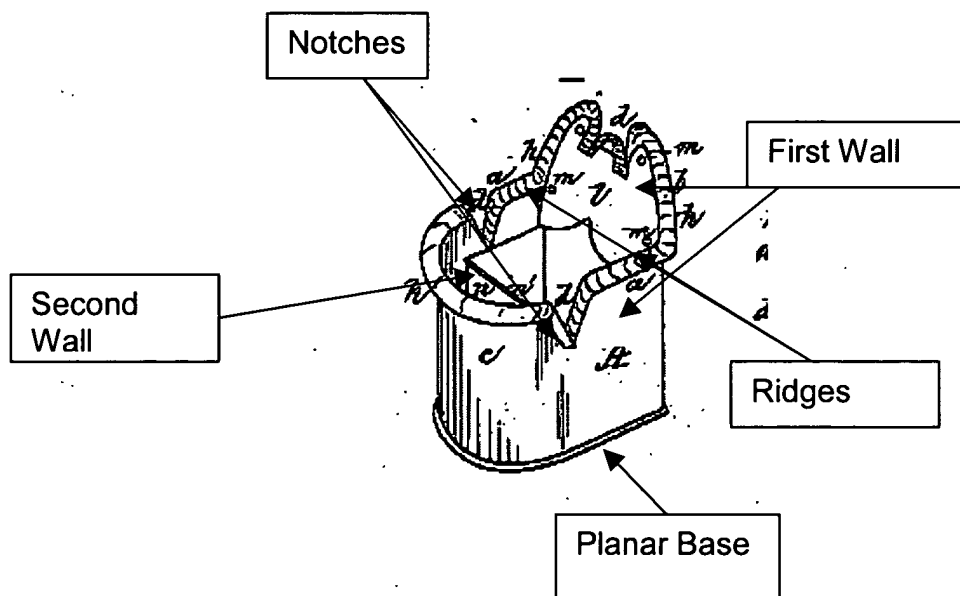
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 333082 to Whitney.

The patent to Whitney discloses a cooking utensil holder having a generally planar base (See Marked up Drawing Below), a wall (v, A) existing at a right angle and extending vertically at one end of the base with a commensurable height as the length of the base, a second wall (n'), existing at a right angle and extending vertically at the opposite end of parallel to the first wall, a space existing between the first and second

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wall, a receptacle (n) existing within the surface of the base, between the first and second wall, which extends at a right angle up one or both vertical walls, and opening (a) originating at the top of the first vertical wall (v) and continuing downward to approximately midway of the wall, two raised ridges (a) along the side of the channel or receptacle which remains elevated from condensation and a small v-shaped notch (d) along the raised ridge at the point wherein the ridge meets the first vertical walls.

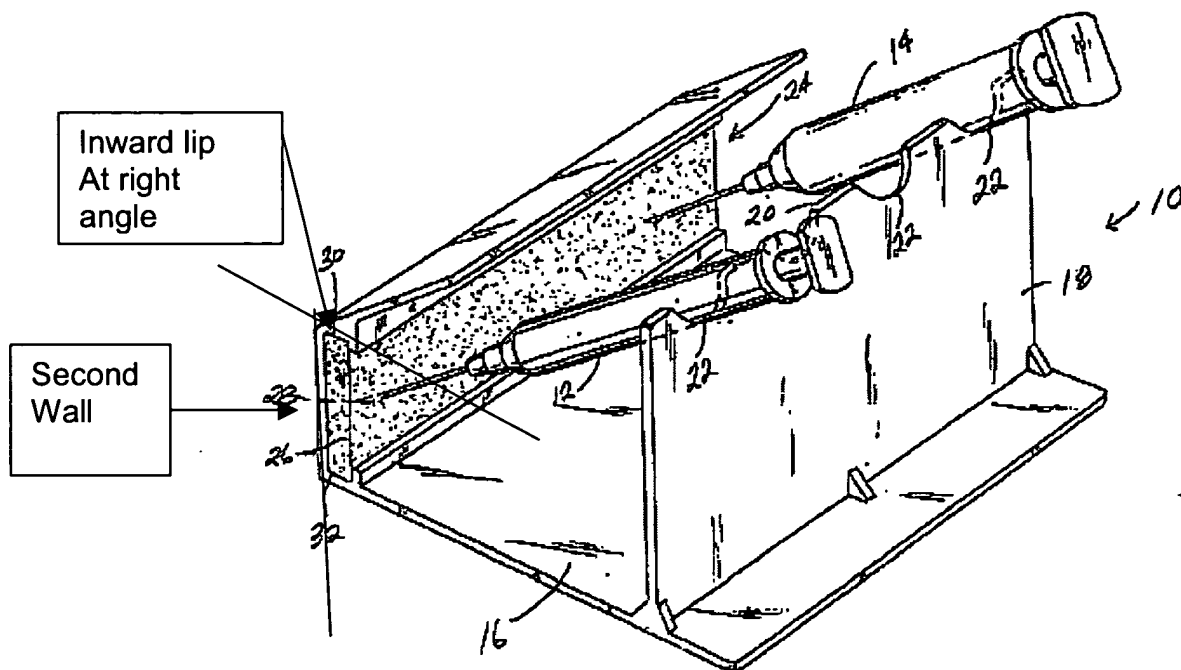


Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent Publication No. 2002/0014560 to Diamond.

The Diamond reference discloses a device (10) with a generally planar base (16), a first wall at a right angle (18) and extending vertically at one end of the base commensurable in height to the length of the base (16), a second wall (See Marked up Drawing Below) existing at a right angle and extending vertically at the opposite end

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and parallel to the first wall and a space existing between the first and second wall, wherein the first wall extends half the height of the first wall and presents at a right angle an inward projection or lip (30), the width of the wall.



Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following documents show various holding devices

6012593 to Knittel et al.

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4911310 to Raishe et al.

3326387 to Princevalle

2664005 to Kosinski

1886075 to Zorsch

1052813 to Gibbons

D491769 to Qualiano

D408229 to Hong

D379903 to Durham

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 703-308-3271. The examiner can normally be reached (M-F 8 a.m.-5:00 p.m.). If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine number for the Technology center is 703-872-9306 (formal amendments) or 703-308-3519 (informal amendments/communications).

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 703-308-2168.



AJS
Amy J. Sterling
10/19/04



ANITA KING
PRIMARY EXAMINER